

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No.19

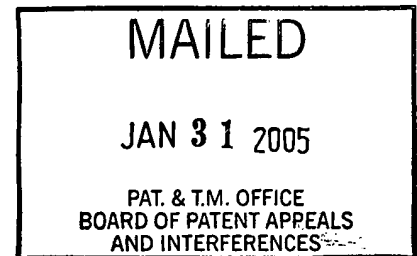
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLEN J. ANDERSON and JOHN S. LOVE

Appeal No. 2004-2243
Application No. 09/365,731

ON BRIEF



Before KRASS, RUGGIERO, and MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-22.

Invention

Appellants' invention relates to a system and method for providing a context-sensitive status or help display that is either physically or virtually separate from the application program display. That is, the status or help display does not conceal or otherwise interfere with the main output of the application program. Appellants' specification at page 1, lines 31-36.

Claims 1 and 12 are representative of the claimed invention are reproduced as follows:

1. A computer system comprising:

first display means having a predetermined first display area dedicated to displaying a main window of an application program;

second display means having a predetermined second display area dedicated to displaying auxiliary information related to the application program; and

means, responsive to the application program, for separately routing the main window exclusively to the first display area and the auxiliary information exclusively to the second display area so that display of the auxiliary information never overlaps display of the main window.

12. A method for displaying auxiliary information to prevent overlap with display of a main window of an application program, the method comprising the steps of:

routing and displaying the main window of the application program to a first dedicated display area that cannot display the auxiliary information; and

separately routing the auxiliary information to a second dedicated display area that cannot display the main window, so that display of the auxiliary information never overlaps display of the main window.

References

The references relied on by the Examiner are as follows:

Dazey et al. (Dazey)	5,715,415	Feb. 3, 1998
Endres et al. (Endres)	6,104,359	Aug. 15, 2000

Rejections At Issue

Claims 1, 3-4, 8-12, 14-15, and 19-22 stand rejected under 35 U.S.C. § 102 as being anticipated by Dazey.

Claims 2, 5-7, 13, and 16-18 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Dazey and Endres.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1, 3-4, 8-12, 14-15, and 19-22 under 35 U.S.C. § 102; and we affirm the Examiner's rejection of claims 2, 5-7, 13, and 16-18 under 35 U.S.C. § 103.

Although we reach the same conclusion on the merits, our analysis of the Dazey reference differs from that of the Examiner. Therefore, we deem our analysis in this decision to be a new grounds of rejection pursuant to 37 CFR § 41.50(b).

¹ Appellants filed an appeal brief on August 19, 2003. The Examiner mailed an Examiner's Answer on November 8, 2003.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal the claims stand or fall together in two groupings:

Claims 1-11 as Group I; and

Claims 12-22 as Group II.

See page 3 of the brief. Furthermore, Appellants argue each group of claims separately and explains why the claims of each group are believed to be separately patentable. See pages 3-7 of the brief. However, Appellants have not fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) stated:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an

argument as to why the claims are separately patentable. (Emphasis added)

We will, thereby, consider Appellants' claims as standing or falling together in four groups as follows:

Claims 1, 3-4, and 8-11 as Group I;

Claims 2 and 5-7 as Group II;

Claims 12, 14-15, and 19-22 as Group III; and

Claims 13 and 16-18 as Group IV.

We will treat:

Claim 1 as a representative claim of Group I;

Claim 2 as a representative claim of Group II;

Claim 12 as a representative claim of Group III; and

Claim 13 as a representative claim of Group IV.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1, 3-4, and 8-11 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Dazey does fully meet the invention as recited in claims 1, 3-4, and 8-11.

Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue at page 4 of the brief:

A careful reading of the Dazey patent shows that the computer application with help pane suffers from the same shortcomings as the rest of the prior art, namely, that where there is a dedicated main window of an application program displayed on a screen, whenever auxiliary information is to be displayed, the auxiliary information at some point overlaps the application program in the main window and invades the exclusive display area for the main window.

Appellants then direct this Board's attention to Dazey at column 5, lines 27-37, which repeatedly states that the help pane "covers" a portion of the publication (or its workspace) and that the "publication is re-sized." Although on the surface Appellants' arguments would seem to be persuasive, we find that upon closer examination they are not persuasive.

Our review of Dazey's figures 4 and 5, which are discussed in the section cited by Appellants, finds that the help pane 70 does not actually overlap the workspace 50 as contented by Appellants. Rather, the help pane only

"appears to cover" a portion of the publication (or its workspace). In figures 4 and 5, we find that the help pane 70 and the workspace 50 each have a scrollbar (unlabelled) on their respective right sides. We find that an artisan would understand the scrollbar on the right side of workspace 50 to be the rightmost extent of workspace 50. We find that figures 4 and 5 show that help pane 70 does not overlap the workspace 50 scrollbar and hence does not overlap the workspace itself.

Our findings above are reinforced by Dazey at column 5, lines 33-37. If there are two non-overlapping display areas where the help pane "appears to cover" the workspace, then re-sizing the publication within the workspace, rather than re-sizing the workspace, would be the appropriate action to take after opening the help pane. Conversely, if the help pane actually "covers" (overlaps) the workspace, then re-sizing the workspace, rather than re-sizing the document would be the appropriate action. Contrary to Appellants' argument at page 4 of the brief that window 50 of Dazey is re-sized; lines 33-37 of column 5 clearly state that it is publication 52 that is resized. This would indicate to an artisan that there are two non-overlapping display areas.

We find that there is an obvious error in the text of Dazey at column 5, lines 27-32. We further find that (a) one skilled in art would recognize this error and (b) based

on the figures and remainder of the text one skilled in art would interpret "cover" or "covers" as "appears to cover."

Appellants also argue at page 5 of the brief, "the reference does not teach . . . that the display of the auxiliary information never overlaps the display of the main window." To support this argument Appellants point out, "according to the Dazey patent, the help pane 70 is actually in the display area that was previously occupied by window 50." We do not find this argument persuasive.

We find nothing in the language of claim 1 that precludes displaying the auxiliary information in the display area that was previously occupied by the main window. Rather, we find the language of claim 1 precludes displaying the auxiliary information in the display area that is now occupied by the main window.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 2 and 5-7 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 2 and 5-7. Accordingly, we affirm.

With respect to dependent claim 2, Appellants refer to their arguments with respect to claim 1 and present no separate arguments directed to claim 2. We have fully addressed the claim 1 arguments above and we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the reasons above.

III. Whether the Rejection of Claims 12, 14-15, and 19-22 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Dazey does fully meet the invention as recited in claims 12, 14-15, and 19-22. Accordingly, we affirm.

With respect to independent claim 12, Appellants argue at page 5 of the brief, "the Dazey patent, neither teaches nor suggests . . . a first dedicated display area that cannot display the auxiliary information; and . . . a second dedicated display area that cannot display the main window." To determine whether claim 12 is anticipated by the reference, we must first determine the scope of the claim.

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be

attributed to those words by persons skilled in the relevant art." *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we fail to find any definition of the term "dedicated" that is different from the ordinary meaning. We find the ordinary meaning of the term "dedicated" is best found in the dictionary. We note that the definition most suitable for "dedicated" is "set apart for a special use."²

Upon our review of Appellants' specification, we fail to find any definition of the term "cannot" that is different from the ordinary meaning. We find the ordinary meaning of the term "cannot" is best found in the dictionary. We note that the definition most suitable for "cannot" is "the negative form of *can*."³ In turn we note that the definition most suitable for "can" is "possession of a specified capability."⁴ Therefore, we find "cannot" to mean, "does not possess the specified capability."

² The American Heritage Dictionary, Second College Edition, 1982, page 373. Copy provided to Appellant.

³ *Ibid*, page 234. Copy provided to Appellant.

⁴ *Ibid*, page 232. Copy provided to Appellant.

We find that the language of claim 12 requires "a first display area set apart for a special use that does not possess the capability to display the auxiliary information; and . . . a second display area set apart for a special use that does not possess the capability to display the main window." We appreciate the Appellants' position that "a dedicated display area that cannot display" is not taught by Dazey. However, we find that Dazey in column 4, lines 57-65, teaches that in response to button 66 the window 44 is partitioned into two non-overlapping panes (workspace 50 and help pane 70) within a single graphical window. Each pane is a display area set apart for a special use (work or help) that does not possess the capability to display the other pane's information. Contrary to Appellants' arguments, we find that Dazey does teach, "a first dedicated display area that cannot display the auxiliary information; and . . . a second dedicated display area that cannot display the main window."

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

IV. Whether the Rejection of Claims 13 and 16-18 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of

ordinary skill in the art the invention as set forth in claims 13 and 16-18. Accordingly, we affirm.

With respect to dependent claim 13, Appellants refer to their arguments with respect to claim 12 and present no separate arguments directed to claim 13. We have fully addressed the claim 12 arguments above and we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the reasons above.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1, 3-4, 8-12, 14-15, and 19-22; and we have sustained the rejection under 35 U.S.C. § 103 of claims 2, 5-7, 13, and 16-18.

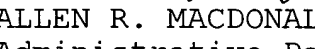
As indicated *supra*, we deem our analysis in this decision to be a new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg. 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)). 37 CFR § 41.50(b) provides that, "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review."

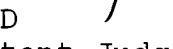
37 CFR § 41.50(b) also provides that the Appellant, ***WITHIN TWO MONTHS FROM THE DATE OF THE DECISION***, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of


proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .
- (2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record . . .

AFFIRMED; 37 CFR § 41.50 (b)

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ERROL A. KRASS)
Administrative Patent Judge)

) BOARD OF PATENT
JOSEPH F. RUGGIERO)
Administrative Patent Judge) APPEALS AND

) INTERFERENCES
ALLEN R. MACDONALD)
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